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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,857	10/25/2001	Mark G. Erlander	485772002900	1235
7590	02/11/2004		EXAMINER	
Townsend and Townsend and Crew LLP Kawai Lau 12730 High Bluff Drive Suite 400 San Diego, CA 92130			TUNG, JOYCE	
			ART UNIT	PAPER NUMBER
			1637	
			DATE MAILED: 02/11/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/062,857	ERLANDER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Joyce Tung	1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 12 November 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-32 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-32 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) Other: \_\_\_\_\_

### **DETAILED ACTION**

Following the entry of the amendment filed 11/12/2003, the claims 1-32 are pending.

Rejections and/or objected from the previous office action are hereby withdrawn. The following rejections are either newly applied or reiterated. They constitute the complete set presently being applied to the instant application.

1. Claims 1-32 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al. (US 2002/0137709 A1, September 26, 2002), in view of Adams et al. (US 6,297,365 B1, October 2, 2001).

Applicant's arguments filed 11/12/2003 have been fully considered but they are not persuasive. The response argues that Lin et al. do not disclose "a plurality of second oligonucleotides comprising a random primer region". As disclosed in Example 5, paragraph 0104 of the reference of Lin et al. there is a primer, the oligo(dC)-N, with the single variable position "N" at its 3' end. It is interpreted as the primer which has a random primer region.

The response further argues that "a random primer region" as recited in claim 1 refers to a "region" of at least 2 bases that is both a primer and random in nature. However, the limitations discussed herein are not recited in the claims 1 and 17.

Thus, based upon the analysis above, the rejection is maintained.

2. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shannon (US 6,132,997) in view of Adams et al. (US 6,297,365).

Applicant's arguments filed 11/12/2003 have been fully considered but they are not persuasive. The response argues that Shannon does not disclose the primer which has a random primer region as recited in claims 1 and 17. However, Shannon disclose a promoter linked oligo

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dT primer that contains some variable positions at its 3' end (See column 4, lines 50-63) to produce a promoter linked duplex cDNA. The primer used in the method of Shannon is interpreted as a primer which has a random primer region. Thus the rejection is maintained.

3. Claims 1-32 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al. (US 2003/0022318), in view of Adams et al. (US 6,297,365).

Applicant's arguments filed 11/12/2003 have been fully considered but they are not persuasive. The response argues that the enzymatic activities of Lin et al. (2003) are not simultaneously used and primers are not simultaneously used. However, claims 1 and 17 do not recite the limitation which requires the enzymes and primers simultaneously used in the method. Thus, the limitations discussed in the response are not in the claims. Therefore, the rejections are maintained.

### **Summary**

4. No claims are allowable.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (703) 308-1119 on Monday-Friday from 10:00 AM-6:00 PM.

Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

7. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1637 via the PTO Fax Center located in Crystal Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung  
January 7, 2004



ETHAN WHISENANT  
PRIMARY EXAMINER